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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,184	04/09/2004	Rinze Benedictus	8674.006.US0000	8419

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EXAMINER	
MORILLO, JANELL COMBS	
ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
06/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/821,184	**Applicant(s)** BENEDICTUS ET AL.	
	Examiner Janelle Morillo	**Art Unit** 1793	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-10,13-25,28-68,98,99 and 125-127*.
   Claim(s) withdrawn from consideration: *101-124*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Roy King/
Supervisory Patent Examiner, Art Unit 1793

/J. M./
Examiner, Art Unit 1793

Continuation of 3. NOTE: the proposed amended Mn ranges has not previously been considered together with the instant dependent claims.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's argument that the present invention is allowable over the prior art of record because applicant has shown unexpected results in view of the prior art of record has not been found persuasive

1. Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP §716.02(d) - § 716.02(e). Applicant argues that example 8 alloy E (see Tables 14 and 15 of instant specification) which falls within the ranges of alloying elements taught by Chakrabarti, is closer to the instant invention than any of the examples of Chakrabarti. Further, applicant argues that Example 8 alloy F of the present invention exhibits unexpected results with respect to alloy E (unexpected strength and elongation). The examiner agrees that comparison of ex. E and F in Table 15 shows a difference of Mn leads to a difference in strength and elongation, but it is unclear a) how the differing amounts of Mg and Cu effect this as well and b) it is unclear if the unexpected results occur over the entire claimed alloying ranges.

Applicant should establish a nexus between the rebuttal evidence and the claimed invention, i.e., objective evidence of nonobviousness must be attributable to the claimed invention, see MPEP 2144.08. To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 305 n.42, 227 USPQ 657, 673-674 n. 42 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). Comparison must be done under identical condition except for the novel features of the invention. In re Brown, 173 USPQ 685 and In re Chapman, 148 USPQ 711.

More particularly, see Table 2 of the present specification at examples alloy 3 and alloy 20. Comparison of alloy 3 (no Mn addition) and alloy 20 (with Mn), shows that an addition of 0.16% Mn exhibits a very minor increase in strength, and a decrease in UPE (and wherein said alloys have very similar or identical amounts of Cu, Zn, Zr, and close amounts of Mg). It is unclear that the claimed Mn range is critical, and over the entire claimed alloying ranges of Zn, Cu, Mg, Zr, etc.

2. Applicant's similar arguments that the present invention is allowable over the prior art of Shahani because applicant has shown unexpected results with respect to alloys A and E which are closer to the present invention than Shahani alloy X (which applicant argues is the closest example of Shahani). Examples A or E are not clearly closer than example X of Shahani (said examples are held to be just as close). And as stated above, it is unclear if unexpected results occur over the entire claimed alloying ranges.

3. Applicant's argument that the present invention is allowable over the prior art of record because the present invention has achieved commercial success has not been found persuasive. Applicant has not shown specific comparison data detailing that a product commensurate in scope with the instant claims has specific evidence of commercial success with respect to the prior art products (see MPEP 716.03). Additionally, conclusory statements or opinions that commercial success is due to the merits of the invention are entitled to little weight in considering evidence of commercial success. In re Noznick, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. Applicant has not shown a clear nexus between the claimed invention and evidence of commercial success.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 7:30 am- 4:00 pm Mon-Wed.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M./
Examiner, Art Unit 1793
May 28, 2008.